

REMARKS

The Office Action of November 2, 2004, has been received and reviewed. Claims 1-24 are currently pending and all pending claims stand rejected. Applicant proposes to amend claims 1, 5, 11 and 21 as set forth herein. No new matter has been added. All amendments are made without prejudice or disclaimer. Reconsideration is requested.

Objection to the Drawings

Figure 2 was objected to for being dark and difficult to read. Replacement FIG. 2 is submitted herewith. No new matter has been added. Withdrawal of the objection is requested.

Rejections under 35 U.S.C. § 103

Claims 1, 9, 11-17, 19 and 21-23

Claims 1, 9, 11-17, 19 and 21-23 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Chung in view of Swartz et al. Applicant respectfully traverses the rejections as hereinafter set forth.

A *prima facie* case of obviousness cannot be established since the cited references do not alone, or in combination, teach, suggest or motivate each and every element of any of claims 1, 9, 11-17, 19 and 21-23. Although applicant does not agree with any of the obviousness rejections, to expedite prosecution, applicant proposes to amend independent claims 1, 11 and 21 as set forth herein. In such form, these claims are submitted as being allowable over the cited references of record.

Chung does not alone, or in combination with Swartz et al., teach, suggest or motivate each and every element of amended claim 1. As proposed to be amended, claim 1 recites in part electronically disclosing said stored pharmaceutical information to said patient, wherein said stored pharmaceutical information comprises prescription counseling and prompting said patient with an opportunity to accept or decline said prescription counseling by interacting with an electronic input device.

Chung is concerned with the use of RFID technology to **track** medication, while amended claim 1 is directed towards giving prescription counseling to a patient. Swartz et al. is concerned with an improved marketing and shopping system, but does not teach, suggest nor

motivate giving prescription counseling to a patient as recited in amended claim 1. Thus, since Chung does not teach, suggest nor motivate disclosing any prescription counseling or allowing a patient to interact with an electronic input device to accept or decline the prescription counseling, and Swartz et al. does not teach, suggest nor motivate disclosing any prescription counseling to a patient or allowing a patient to interact with an electronic input device to accept or decline the prescription counseling, a *prima facie* case of obviousness cannot be established with regard to amended claim 1.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Thus, dependent claim 9 is non-obvious since it depends from non-obvious independent claim 1.

A *prima facie* case of obviousness also cannot be established with regard to amended claim 11 since Chung does not alone, nor in combination with Swartz et al., teach, suggest or motivate a system for providing interacting pharmaceutical information comprising retrieval means for electronically retrieving stored pharmaceutical information identified by said scanning means, wherein said stored pharmaceutical information comprises prescription counseling along with an electronic input device for interacting with said patient.

Dependent claims 12-17 are non-obvious since they depend from non-obvious independent claim 11. (*See, In re Fine, supra*).

Turning to independent claim 21, it cannot be deemed obvious since Chung and Swartz et al. do not alone, nor in combination, teach, suggest or motivate a computer-based apparatus for providing pharmaceutical information to a patient comprising an electronic communication device for conveying prescription counseling to said patient as recited in amended claim 21. Thus, a *prima facie* case of obviousness cannot be established.

Dependent claims 22 and 23 are non-obvious since they depend from non-obvious independent claim 21. (*See, In re Fine, supra*).

Reconsideration and withdrawal of the obviousness rejections of claims 1, 9, 11-17, 19 and 21-23 are requested.

Claims 2, 4-6 and 10

Claims 2, 4-6 and 10 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Chung in combination with Swartz et al., and further in view of Catan. Applicant respectfully traverses the rejections as set forth herein.

Claims 2, 4-6 and 10 are non-obvious since they depend from non-obvious independent claim 1. (*See, In re Fine, supra*).

Reconsideration and withdrawal of the obviousness rejections of claims 2, 4-6 and 10 are requested.

Claims 7, 20 and 24

Claims 7, 20 and 24 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Chung in combination with Swartz et al. and further in view of Steward. Applicant respectfully traverses the rejections as hereinafter set forth.

Claims 7, and 20 and 24 are non-obvious since they depend from non-obvious independent claims 1 and 21, respectively. (*See, In re Fine, supra*).

Reconsideration and withdrawal of the obviousness rejections of claims 7, 20 and 24 are requested.

Claims 3, 8 and 18

Claims 3, 8 and 18 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Chung in combination with Swartz et al. with Catan, and further in view of Kaafarani et al. Applicant respectfully traverses the rejections as set forth herein.

Claims 3 and 8, and 18 are non-obvious since they depend from non-obvious independent claims 1 and 11, respectively. (*See, In re Fine, supra*).

Reconsideration and withdrawal of the obviousness rejections of claims 3, 8 and 18 are requested.

ENTRY OF AMENDMENTS

The proposed amendments to claims 1, 5, 11 and 21 should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings, and do not add any new matter to the application. Further, the amendments do not raise new issues nor require a further search. For instance, the element of prescription counseling added to claims 1, 11 and 21 further defines the prescription information and, thus, the search for the prescription information would have included the search for prescription counseling. Support for the prescription counseling is found, *inter alia*, at paragraph [0019] of the as-filed application. Further, the element of interactive added to claims 1, 11 and 21 was present in the dependent claims (*see, i.e.*, claims 2 and 4) and, thus, a new search should not be required. If the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested since they certainly more clearly define issues for appeal.

CONCLUSION

In view of the foregoing amendments and remarks, applicant respectfully submits that the claims define patentable subject matter and a notice of allowance is therefore requested. Should questions remain after consideration of the foregoing, the Office is kindly requested to contact the applicant's attorney at the address or telephone number herein.

Respectfully submitted,



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IN THE DRAWINGS:

Accompanying this Amendment is the attached drawing sheet which replaces FIG. 2. This sheet replaces the original sheet for FIG. 2. No new matter has been added.